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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,878	06/29/2000	Akira Uchiyama	551512/062	6860

7590 04/18/2002

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New York, NY 10038

EXAMINER

TALBOT, BRIAN K

ART UNIT PAPER NUMBER

1762

DATE MAILED: 04/18/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/606,878

Applicant(s)

UCHIYAMA, AKIRA

Examiner

Brian K Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-24 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-24 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/25/02 has been entered.

2. Claims 1,3-24 and 40 remain in the application.

3. In light of the amendment filed 3/25/02, the 35 USC 112 first paragraph rejection has been withdrawn.

***Claim Rejections - 35 USC § 103***

4. Claims 1,3-24 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted state of the art (specification, pg. 1-3) in combination with either Thoma (4,588,480), Rothschild et al. (4,938,850), Beaty (5,603,338), Angell (3,650,861), Fahrmbacher-Lutz et al. (4,525,250) or Dotzer et al. (3,969,195).

Applicant's admitted state of the art (specification, pg. 1-3) teaches watches made of aluminum or aluminum alloys covered with a transparent protective film are known. The

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specification further teaches that titanium and titanium alloys are known to be utilized in forming watches. however, oxidation of the titanium materials is a problem.

Applicant's admitted state of the art (specification, pg. 1-3) fails to teach removing "adhesion substances" from the titanium surfaces prior to applying the transparent protective film.

Thoma (4,588,480), Rothschild et al. (4,938,850), Beaty (5,603,338), Angell (3,650,861), Fahrmbacher-Lutz et al. (4,525,250) or Dotzer et al. (3,969,195) all individually teach the importance of removing "native oxides, i.e. titanium oxide" and impurities on the surface of titanium prior to subsequent plating processes.

While the Examiner acknowledges the fact that the references teach a metal plating step as opposed to a transparent protective layer, i.e. glass, the references are relied upon for teaching the known "pretreatment" steps to form a "prepared clean titanium surface" prior to any subsequent coating. It is the Examiner's position that one skilled in the art would recognize that the problems associated with titanium oxide and other impurities would also effect not only metal coating but other coatings as well. Hence, it is the Examiner's position that one skilled in the art at the time the invention was made would have had a reasonable expectation of achieving similar success regardless of the type of subsequent coating.

With respect to the claimed "pretreatment steps" as well as the compositional make up of the glass layer, it is the Examiner's position that these are all "result effective" variables which can be optimized by one skilled in the art. In addition, one skilled in the art would have had a reasonable expectation of achieving similar success regardless of which conventional technique was utilized without the showing of unexpected results.

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5. Claims 1,3-24 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrus et al. (5,298,332) in combination with Takao (4,906,524) further in combination with either Thoma (4,588,480), Rothschild et al. (4,938,850), Beaty (5,603,338), Angell (3,650,861), Fahrmbacher-Lutz et al. (4,525,250) or Dotzer et al. (3,969,195).

Andrus et al. (5,298,332) in combination with Takao (4,906,524) teach applying a ceramic-based coating on ornamental titanium articles.

Andrus et al. (5,298,332) in combination with Takao (4,906,524) fail to teach pretreating the titanium article prior to applying the ceramic-based coating.

Features described above concerning Thoma (4,588,480), Rothschild et al. (4,938,850), Beaty (5,603,338), Angell (3,650,861), Fahrmbacher-Lutz et al. (4,525,250) or Dotzer et al. (3,969,195) are incorporated here.

With respect to the claimed "pretreatment steps" as well as the compositional make up of the glass layer, it is the Examiner's position that these are all "result effective" variables which can be optimized by one skilled in the art. In addition, one skilled in the art would have had a reasonable expectation of achieving similar success regardless of which conventional technique was utilized without the showing of unexpected results.

#### *Response to Amendment*

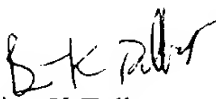
6. Applicant's arguments filed 3/25/02 have been fully considered but they are not persuasive.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K Talbot whose telephone number is (703) 305-3775. The examiner can normally be reached on Tuesday-Friday 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 305-6357 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3775.

  
Brian K Talbot  
Primary Examiner  
Art Unit 1762

BKT  
April 17, 2002